

Docket No.: 50253-113 (P2202)



PATENT

DAC
#11

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

JAKOB NIELSEN

Serial No.: 08/865,841

Filed: May 30, 1997

For: ADAPTIVE META-TAGGING OF WEBSITES



Group Art Unit: 2771

Examiner: J. Mills

RECEIVED
OCT 26 1999
TECH CENTER 2700

PETITION TO THE GROUP DIRECTOR UNDER 37 C.F.R. §1.181(a)

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

This is a petition to the Group Director from the holding of the Examiner that claims 1-26 stand or fall together.

On September 28, 1999 the examiner mailed an Examiner's Answer to Appellant's Appeal Brief filed July 19, 1999. In that Answer, the Examiner held that claims 1-26 stand or fall together.

Specifically, the Examiner's answer states "The rejection of claims 1-26 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7)" (Examiner's Answer, page 4).

In the Appeal Brief Appellant stated specifically "All claims are argued separately and stand or fall independently of any other claim" (Appeal Brief, page 5).

Contrary to the Examiner's holding, the Appeal Brief devoted at least one paragraph to each claim and identified the distinctive element not shown in the prior art. The Court has found

such reasons sufficient for claims to stand or fall separately. *In re BEAVER*, 893 F.2d 329, 13 USPQ2d 1409 (1989 Fed.Cir.).

In *In re Beaver*, the Court reversed a holding by the Board of Patent Appeals and Interferences. In arguing dependent claims, Beaver listed at least one element of the dependent claims and several times asserted “Obviously, neither [reference] discloses” the recited element. The Board held that Beaver had not preserved the independent appeal of claims because “we do not consider a summary of the subject matter of claims 21 through 32 as a separate argument” (Ibid., 1410). The Court found, “Although concise, the arguments pointed out the essential elements as compared with prior claims, and the inapplicability of the cited references, which had previously been discussed in the brief” (Ibid., 1410).

The Court also addressed the special nature of dependent claims, and stated, “The subordinate claims by their nature required fewer words of explanation on appeal. . . . That Beaver did not repeat, in his argument for the subordinate claims, everything he had already said in arguing his principal claims did not convert ‘dependent’ claims into nonentities.” (Ibid., 1410, 1411).

In reversing the Board the Court held, “There is no basis whatsoever for . . . the Board’s holding that no claim after claim 20 had been separately argued” (Ibid., 1411).

The Argument section of the Appeal Brief contains a reason for each independent claim and the inapplicability of the cited references, sometimes referring to reasons “which had previously been discussed in the brief” as found sufficient in *In re Beaver* above. The Appeal Brief also points out the distinct features of each dependent claim that are not found in the prior art references. Such reasons were found sufficient for the claims to stand or fall separately in *In re Beaver*, above. Therefore, the arguments are proper and each claim stands or falls independently of any other claim.

Applicant respectfully requests that the Group Director reverse the Examiner's holding and direct that the claims be treated as separately argued.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY



Eugene J. Molinelli
Registration No. 42,901

600 13th Street, NW
Washington, DC 20005-3096
(202) 756-8600 EJm/pgb:mcm
Date: October 21, 1999
Facsimile: (202) 756-8087